

Appl. No. : 09/661,540
Filed : September 14, 2000

REMARKS

Applicant has the following remarks in response to the Office Action.

Discussion of Status of the Claims

In the Office Action, the Examiner rejected Claims 1-3, 6, 7, 9-13, 16-18, and 22-26. Claims 4, 5, 14, 15, and 19-21 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this paper, Applicant has rewritten the objected to claims into independent form and respectfully requests withdrawal of these objections.

Discussion of Claim Rejections Under 35 U.S.C. §§ 102(e) and 103(a)

In the Office Action, the Examiner rejected Claims 1-3, 6, 7, 11, 16, 22, 25, and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,925, to Nardone (hereinafter "Nardone"). Claims 9, 10, 12, 13, 17, 18, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,625,730, to Angelo (hereinafter "Angelo"). Applicant respectfully disagrees with these rejections for the reasons set forth below.

Claims 1, 2, 6, 11, 16, 22, and 26

In one embodiment, a bootstrap program in a computer determines whether a signature is located in a non-volatile memory that is located in a Basic Input Output Services ("BIOS") circuit. If the signature is located in the non-volatile memory, it will allow access to encoded media in a removable media reading device. Turning to the claims, it is seen that Claim 1, as amended, recites: "a non-volatile memory coupled to said host processor, said non-volatile memory including a predetermined location for storing a signature, wherein the non-volatile memory is located in basic input/output system (BIOS) circuitry of said computer system." Independent Claims 2, 6, 11, 16, 22, and 26 each contain similar types of limitations. Applicant respectfully submits that the cited references fail to teach or suggest that a signature be stored in a BIOS circuit. In the Office Action, stated the following:

Nardone's design makes no mention of storing the predetermined signature in the BIOS circuitry and also in non-volatile memory of the central processing unit. Angelo teaches in column 8, lines 47-51 that it is common to store BIOS in non-volatile memory. Nardone [sic, Angelo] further discloses in column 9, lines 38-48 how signatures can be stored in the BIOS for the purposes of validating the BIOS. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Angelo's teachings on storing signatures in the BIOS, which can be contained in the non-volatile memory or a processor, into Nardone's design in order to achieve a design that is capable of allowing the

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predetermined signature to be stored in the BIOS or non-volatile memory in the central processing unit for the purpose of storing the predetermined signature in an area known to be secure.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicant respectfully submits that the Examiner has failed to provide a valid *prima facie* motivation for combining the cited references. Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the cited references.

Furthermore, where the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency). In the case at hand, the purpose of the signature in Nardone is to verify the content of non-tamper resistant portion of a loadable software component. *See* col. 2, line 66- col. 3, line 1 and Fig. 2. It would be disadvantageous to store the signature of Nardone in a BIOS circuit because the signature must then be pre-stored in the BIOS circuit during the manufacture of the computer or somehow communicated to the BIOS by some other means. It would be more practical to include the signature with the non-tamper resistant portion. For example, in the context of the DVD, if the signature of Nardone was included in a computer BIOS, it would be necessary during manufacture of the computer to include the signature of the non-tamper resistant portion of all DVDs that could be used with the computer system. Furthermore, there is no suggestion in Angelo that the signature that is stored in the BIOS be used for authenticating anything other than the BIOS, such as a DVD or other removable media.

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Since there insufficient motivation in the prior art for the combination suggested, by the Examiner, Applicant respectfully submits that the Examiner has failed to make a valid prima facie rejection and respectfully request allowance of the above-claims.

Claims 3, 10, 13, 18, 24, and 25

Since dependent Claims 3, 10, 13, 18, 24, and 25, each depend on one of independent Claims 1, 6, 11, 16, and 22, Applicant respectfully submits that these claims are allowable for the reasons discussed above and the subject matter of their own limitations.


Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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